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Glen R. Cataline

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HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, N.W.
SUITE 1200
WASHINGTON, DC 20006-1109

EXAMINER

KARMIS, STEFANOS

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 09/985,900 | Applicant(s) CATALINE ET AL. | |
| | Examiner STEFANOS KARMIS | Art Unit 3693 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 48, 49, 52-77 and 79 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 48, 49, 52-77, and 79 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following communication is in response to Applicant's amendment filed on 01 July 2009.

Status of Claims

2. Claims 48, 52, 73, and 79 are currently amended. Claims 48, 49, 52-77, and 79 are currently pending.

Response to Arguments

3. Applicant argues that Johnson fails to teach *performing, after identifying the single payment source and the payee account, an optimization determination to determine a payment mechanism to use to transfer the funds from the single payment source to the payee account, the processor using the first information and payment platform information in the optimization determination.*

Regarding the independent claims, the thrust of Applicant's argument is that Johnson fails to teach that the determination can be performed automatically and Applicant argues that the citations from Johnson are merely boilerplate language. The Examiner respectfully disagrees. First, Examiner notes that the term automatically is not in Applicant's claim. Applicant is equating automatically as being done by a processor and therefore this is how it is interpreted by the Examiner. As noted before, Johnson teaches that a processor can identify a single payment source based on payment source information (column 13, lines 19-20 and column 14, lines 5-9; Examiner notes that the user only has to enter one payment method/source and the transaction evaluator selects a single payment source). Johnson teaches that the identified single payment source could be a checking account (column 17, line 65 thru column 18, line 14).

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Johnson further teaches that payment from the checking account can be made via ACH transaction or debit card transaction or alternate channel (column 17, line 65 thru column 18, line 14). Johnson further teaches that this determination can be performed automatically, using a computer processor in conjunction with the transaction evaluator (column 19, lines 21-52 and Figure 2 and Figure 3).

Specifically, Johnson states that both the transaction benefit and economic utility are computations are preferably performed automatically with one or more general purpose or specialized computers which are attached to one or more computer networks and receive information about the transactions and transmit results (column 19, lines 38-52). Therefore, Johnson does teach that the determinations, which are determined from the transaction benefit and economic utility computations are performed automatically. Further, the Examiner notes that this does not qualify as boilerplate language, as a description of the computer used for such automation is given. Given a fair reading of the reference, Johnson discloses the computer processors perform the transaction benefit and economic utility computations and therefore the optimizations are performed by a computer processor. Therefore, Applicant's argument is not persuasive.

4. Applicant also argues that Johnson fails to teach a second optimization for determining the payment source. As discussed above, Johnson discloses an optimization for determining a payment mechanism. Johnson also discloses a second optimization that determines payment source (column 10, lines 32-57 and column 12, lines 1-34 and column 15, lines 48-51).

Examiner notes that the transaction evaluator chooses between a credit card and checking account. Therefore, when put together, one optimization could choose the checking account as

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the payment source, and the second optimization can choose the ACH as the mechanism for processing the checking account payment. Therefore, Johnson does teach two distinct optimizations and Applicant's arguments are not persuasive.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 48, 49, 52-77, and 79 are rejected under 35 U.S.C. 102(e) as being anticipated by Johnson et al. (hereinafter Johnson).

Regarding independent claims 48 and 73, Johnson teaches a system for managing transmission of funds for a payment initiator, comprising:

an input portion that inputs first information from a payment request initiator, the first information including payment source information and payee information (column 9, line 64 thru column 10, line 31 and column 11, lines 39-67);

a payment platform database that includes payment platform information (column 9, line 64 thru column 10, line 31 and column 11, lines 39-67 and column 18, lines 44 thru column 19, lines 20);

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a processor, the processor communicating with the input portion and the payment platform database so as to input the first information and access select payment platform data, the processor (column 10, lines 32-57 and column 12, lines 1-34):

identifying a single payment source based on the payment source information, the single payment source being the source of funds for the transmission of funds (column 10, lines 32-57 and column 12, lines 1-34);

identifying a payee account based on the payee information (column 10, lines 32-57 and column 12, lines 1-34);

performing, after identifying the single payment source and the payee account, an optimization determination to determine a payment mechanism to use to transfer the funds from the single payment source to the payee account, the processor using the first information and payment platform information in the optimization determination (column 10, lines 32-57 and column 12, lines 1-34 and column 17, line 65 thru column 18, line 43; Examiner notes the system further determines which of several ways to process a transaction based on a cost/benefit analysis. For example it compares processing from a checking account (single source) by either ACH debit versus debit card; see also column 26, lines 55-64);

effecting the transmission of funds from the single payment source to the payee account using the payment mechanism (column 10, line 58 thru column 11, line 14); and

wherein the processor identifying a single payment source includes the processor performing a second optimization process to determine the single payment source (column 10, lines 32-57 and column 12, lines 1-34 and column 15, lines 48-51).

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wherein the processor inputs a plurality of selected payment sources, and performs the second optimization determination to determine which one of the selected payment sources is the single payment source (column 10, lines 32-57 and column 12, lines 1-34 and column 15, lines 48-51).

Claim 49, wherein the processor identifying a single payment source includes the processor inputting the single payment source from the input portion (column 10, lines 32-57 and column 12, lines 1-34).

Claim 52, wherein the input portion provides for the payment initiator to select the plurality of selected payment sources (column 9, lines 18-28 and column 10, lines 32-57 and column 12, lines 1-34 and column 15, lines 48-51).

Claims 53 and 54, wherein a payment initiator is presented with at least two mechanisms that meet the payment schedule data and associated costs of the at least two mechanisms, and the payment initiator is permitted to manually choose an optimal method of transfer (column 12, line 59 thru column 13, line 3 and column 14, lines 16-21).

Regarding claim 55, wherein the processor determines from a set of payment mechanisms, a reduced set of payment mechanisms, the reduced set being a set of payment mechanisms from which one payment mechanism is determined to effect the transmission of

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funds, the reduced set of payment mechanisms including at least two payment mechanisms (Johnson discloses an entire set of payment mechanisms that the invention supports (column 24, lines 60 thru column 25, line 7. Johnson further teaches in an embodiment that the transaction evaluator identifies the payment methods supported by the customers of which the customer can have at least two (column 24, lines 10-23; thus reducing the set of payment mechanisms). Examiner notes that the reduced set of payment mechanisms is done prior to performing the optimization determination. Similarly, the step in Johnson of the transaction evaluator identifying the payment methods is done before the analysis of which payment method to select. Once the entire set of available payment mechanisms is reduced to the customer's set of payment mechanisms, the transaction evaluator the reduced the customer set of payment mechanisms using the optimization process to determine the appropriate payment method (column 24, lines 33-43).

Claim 56, the optimization determination comprises a calculation of at least one payment source data, payee account data, payment schedule data, payment type data and privacy data (column 10, lines 32-57 and column 12, lines 1-41 and column 17, lines 53 thru column 18, line 14).

Claim 57, wherein the at least one payment source comprises a calculation of at least one of a direct deposit account, a source credit account, a mortgage account, a securities account, a money market account, a micro payment account, an overdraft account and a stored value account (column 24, lines 60 thru column 25, line 8).

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Claim 58, the at least one payee account comprises at least one of a utility account, a mortgage account, a payee credit account and a contribution account (column 5, line 64 thru column 6, line 7).

Claim 59, wherein at least one of the first interface and the second interface comprises a telephone connection (column 25, line 52 thru column 26, line 16).

Claim 60, wherein at least one of the first and the second interface comprises a network connection (column 25, line 52 thru column 26, line 16).

Claims 61, the network connection comprises a remote client from which a user may communicate transaction instructions (column 25, line 52 thru column 26, line 16).

Claim 62, the remote client comprises at least one of a computer, a network-enabled cellular telephone, a portable digital assistant, a paging device, and a set-top box (column 25, line 52 thru column 26, line 16).

Claim 63, the user comprises at least one of a consumer, a business entity and a government entity (column 28, lines 26-52).

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Claim 64, wherein at least one of the first interface and the second interface comprises a desktop graphical user interface directly communicating with the processor (column 28, lines 5-12).

Claim 65, wherein the optimization determination includes at least one of minimizing a cost variable, fulfilling a transaction schedule, minimizing a payment penalty, maximizing a float of the at least one source account, ensuring an affiliation between the payment source and the payee account, maximizing security, maximizing reliability, minimizing risk, fulfilling a contractual obligation, maximizing volume discounts, aggregating a transaction amount, maximizing a transaction amount and maximizing available bonus awards (column 16, lines 9-46, column 18, line 44 thru column 19, line 20 and column 21, lines 3-28).

Claim 66, wherein the optimization determination includes: the processor performing so as to identify an affiliation between the single payment source and the payee account; and determining the payment mechanism based on the identified affiliation (column 10, lines 32-57 and column 23, line 45 thru column 24, line 57).

Claim 67, wherein the optimization determination comprises minimizing a cost variable, and the cost variable comprises at least one of a transaction cost charged to a payment initiator and an internal cost absorbed by a payment enabler (column 12, lines 1-41 and column 17, line 53 thru column 18, line 14).

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Claim 68, the optimization determination comprises utilization of third party association and payment providers (column 5, line 53 thru column 6, line 8 column 20, line 57 thru column 21, line 2).

Claim 69, wherein members of the third party associations are systematically identified by at least one of real time calls to the third party associations, and real time calls to a datastore containing third party association member data which is periodically updated (column 5, line 53 thru column 6, line 8 column 20, line 57 thru column 21, line 2).

Claim 70, wherein an expense reduction resulting from optimization of the cost variable is realized by at least one of the payment enabler and the payment initiator (column 12, lines 1-41 and column 17, line 53 thru column 18, line 14).

Claim 71, the optimization determination comprises a systematic identification and internal settlement for closed loop payments in which the payment source and the at least one payee account reside within one entity (column 5, line 53 thru column 6, line 8 column 20, line 57 thru column 21, line 2).

Claim 72, wherein the transmission of funds comprises a currency conversion (column 25, lines 29-51).

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Claim 74, wherein performing the optimization determination comprises maximizing volume discounts (column 21, lines 3-28).

Claim 75, wherein the optimization determination comprises aggregating a transaction amount (column 12, lines 55-58).

Claim 76, wherein performing the optimization determination comprises maximizing a transaction amount and maximizing available bonus awards (column 9, lines 29-42 and column 21, lines 3-28).

Claim 77, the payment source comprises at least one selected from the group consisting of a checking or other demand deposit account, money market fund, securities account, stored value account, credit card account, currency account, overdraft line of credit, micro payment account and line of credit (column 24, line 60 thru column 25, line 8).

Regarding independent claim 79, Johnson teaches a system for managing transmission of funds for a payment initiator, comprising:

an input portion that inputs first information from a payment request initiator, the first information including payment source information and payee information (column 9, line 64 thru column 10, line 31 and column 11, lines 39-67);

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a payment platform database that includes payment platform information (column 9, line 64 thru column 10, line 31 and column 11, lines 39-67 and column 18, lines 44 thru column 19, lines 20);

a processor, the processor communicating with the input portion and the payment platform database so as to input the first information and access select payment platform data, the processor (column 10, lines 32-57 and column 12, lines 1-34):

identifying a single payment source based on the payment source information, the single payment source being the source of funds for the transmission of funds (column 10, lines 32-57 and column 12, lines 1-34);

identifying a payee account based on the payee information (column 10, lines 32-57 and column 12, lines 1-34);

performing, after identifying the single payment source and the payee account, an optimization determination to determine a payment mechanism to use to transfer the funds from the single payment source to the payee account, the processor using the first information and payment platform information in the optimization determination (column 10, lines 32-57 and column 12, lines 1-34 and column 17, line 65 thru column 18, line 43; Examiner notes the system further determines which of several ways to process a transaction based on a cost/benefit analysis. For example it compares processing from a checking account (single source) by either ACH debit versus debit card; see also column 26, lines 55-64); and

effecting the transmission of funds from the single payment source to the payee account using the payment mechanism (column 10, line 58 thru column 11, line 14);

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the processor identifying a single payment source includes the processor performing a second optimization process to determine the single payment source (column 10, lines 32-57 and column 12, lines 1-34 and column 15, lines 48-51).

the input portion provides for the payment initiator to select the plurality of selected payment sources (column 9, lines 18-28 and column 10, lines 32-57 and column 12, lines 1-34 and column 15, lines 48-51).

wherein the optimization determination comprises a calculation of at least one payment source data, payee account data, payment schedule data, payment type data and privacy data (column 10, lines 32-57 and column 12, lines 1-41 and column 17, lines 53 thru column 18, line 14).

wherein the optimization determination includes minimizing a cost variable, consideration of risk, and determination of whether there is an affiliation between the single payment source and the payee account (column 16, lines 9-46, column 18, line 44 thru column 19, line 20 and column 21, lines 3-28); and

the processor further performing a second optimization process, the second optimization process selecting the single payment source from a plurality of payment sources based on parameters (column 16, lines 19-46 and column 10, lines 32-57 and column 12, lines 1-34 and column 15, lines 48-51).

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Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEFANOS KARMIS whose telephone number is (571)272-6744. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully Submitted
/Stefanos Karmis/
Primary Examiner, Art Unit 3693
11 September 2009